

Applicant: Don S. Rawlings
Filed: September 13, 2004
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Examiner: Joseph M. Pelham
Serial No.: 10/711,349

REMARKS/ARGUMENTS

Claims 1-20 are pending in the application and stand rejected.

In this paper, claims 2, 6, 7, 10, 11, 13, and 14 have been cancelled without prejudice, and claims 1, 3, 5, 8, 9, and 15-20 have been amended.

Applicants believe the amendments made herein add no new matter. Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto.

Reconsideration and reexamination of the application is respectfully requested in view of the amendments and the following remarks.

Rejection Under 35 U.S.C. §102(e)

Claims 1-3 and 5-20 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,650,457 to Busscher et al. The rejection is traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367; 231 USPQ 81 (Fed. Cir. 1986). To anticipate, a single reference must teach each and every limitation of the claimed invention. *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335; 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226; 9 USPQ2d 1913 (Fed. Cir. 1989).

Claim 1, the sole independent claim, has been amended and now calls for a vehicular mirror system comprising an exterior mirror assembly including a reflective element, an electrochromic dimming element, a support member, and a power distributor. The reflective element provides a rearward view to an occupant of the vehicle, and comprises the electrochromic dimming element and at least one dimming element contact for providing electric

power to the electrochromic dimming element. The support member supports the reflective element, and comprises at least a heater tracing for heating the reflective element and at least one selectively located electric power contact. The power distributor is coupled with the support member for distributing power from a single electrical power connector to the at least one selectively located electric power contact and the heater tracing. The power distributor comprises a plurality of electrical leads corresponding to each of the electrochromic dimming element and the heater tracing. The at least one selectively located electric power contact is coupled with the at least one dimming element contact when the support member is brought into aligned contact with the reflective element so that power is selectively provided to the electrochromic mirror dimming element and the heater tracing.

Busscher '457 discloses a mirror assembly 20 comprising an electrochromic mirror subassembly 24 comprising a carrier 36 supporting a heater 26 and a turn signal device 27. The electrochromic element 25, heater 26, and turn signal device 27 have individual connectors that each plug into a multi-prong, multi-receptacle main connector 28 which is, in turn, coupled to a wire bundle 23. The individual connectors for each element 25, 26, 27 must, therefore, be separately connected into the main connector 28 during assembly of the mirror. *Busscher '457, col. 7, ln. 43-67.*

Busscher '457 does not disclose a mirror system having electric power contacts on the support member, i.e. the carrier 36, which are coupled with a dimming element contact when the support member is brought into aligned contact with the reflective element. No coupling of electric power contacts is disclosed by Busscher '457 when the reflective element is brought into contact with the carrier 36. Indeed, in order to complete the electrical power connection of the elements 25, 26, 27 with the vehicle power supply, it is necessary to individually connect the connectors for each element 25, 26, 27 to the main connector 28. This is entirely different than what is called for in amended claim 1.

Because Busscher '457 does not teach each and every limitation of the invention of claim 1, and does not show the identical invention in as complete detail as is contained in claim 1, claim 1 is patentable over Busscher '457.

Since claims 2, 3, and 5-20 depend, directly or indirectly, from claim 1, they are for the same reason patentable over Busscher '457. Applicant requests that the rejection be withdrawn, and that claims 1-3 and 5-20 be allowed.

Rejection Under 35 U.S.C. §103(a)

Claim 4 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Busscher '457. The rejection is traversed.

The Examiner asserts that Busscher '457 "does not explicitly disclose a ribbon type power connector." The Examiner concludes that "this does not patently distinguish the claimed invention from the prior art" because Busscher '457 discloses a power supply comprising a wire "bundle," and such a "bundle" is commonly implemented in the form of a ribbon connector. Consequently, it would have been obvious to one of ordinary skill in the art to use a ribbon connector for the "bundle" of Busscher '457.

The standards for a finding of obviousness must be strictly adhered to. Simply citing one or more prior art references that illustrate different facets of the invention and then concluding that it would be obvious to combine the references to create the applicant's invention is wholly inadequate.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is **a legal conclusion based on underlying findings of fact.**¹

¹ The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention**....Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination** that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."**

In Re Werner Kotzab, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The combination as asserted in the Office action fails to identify any motivation, suggestion, or teaching of the desirability of modifying Busscher '457 to arrive at Applicant's invention. There has been no statement identified in Busscher '457 as to the desirability of the asserted modification, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the teaching of Busscher '457, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for a showing of motivation. The Examiner fails to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of modifying Busscher '457. The Examiner simply relies upon "broad conclusory statements standing alone," which can only lead to the conclusion that the Examiner is simply relying on impermissible hindsight reconstruction of Applicant's invention.

Presumably, the inventors of the Busscher '457 assembly would have selected, and so disclosed, a preferred configuration of the wire "bundle" as well as alternate configurations. Nowhere in Busscher '457 is a ribbon connector disclosed even though, at the time of the Busscher '457 invention, such connectors would have presumably been known to the inventors. It is very likely that the inventors selected the connector best suited for the Busscher '457 assembly. Thus, there would be no motivation to modify the Busscher '457 assembly to include a cable connector.

Even if the combination were proper, the modification of Busscher '457 would not reach Applicant's invention. As discussed above, amended claim 1, from which claim 4 depends, calls for a mirror system having electric power contacts on the support member which are coupled with a dimming element contact when the support member is brought into aligned contact with the reflective element, which is not disclosed in Busscher '457. The addition of a cable connector does not overcome this deficiency. Thus, the asserted modification of Busscher '457 does not reach the invention of claim 4.

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For these reasons, claim 4 is patentable over Busscher '457. Applicant requests withdrawal of the rejection, and the allowance of claim 4.

It is respectfully submitted that all of the claims in the application are allowable over the prior art of record. Prompt notification of allowability is respectfully requested.

Respectfully submitted,
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